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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,530	02/21/2002	Peter Strehlke	SCH-1805	3053

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EXAMINER

LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,530	STREHLKE ET AL.	
	Examiner	Art Unit	
	Hong Liu	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

References Cited

PTO-892)
Person's Patent Drawing Review (PTO-948)
Disclosure Statement(s) (PTO-1449) Paper No(s) 1.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-16 are pending in this application.

Election/Restrictions

Applicants' election of Group I subject matter along with species of Example #114 with traverse is noted but is not found persuasive for the following reasons. Restriction is proper when there is a lack of unity of invention and such is not affected by the manner of claiming-i.e. in separate claims or within a single claim. As stated in the previous action the resultant compounds embraced by different bicyclic core constitute structurally dissimilar compounds. Placing all such compounds into the same claim is repugnant to scientific classification as they are separately classified and require separate literature searches. As indicated in the previous office action, each of the groups belongs to a separate class and numerous subclasses. To search all the patents under these classes and subclasses would place a substantial burden on the examiner, let alone search of other non-patent literature. Having a common utility among the groups is not enough where as herein there is not a substantial structure feature common to all groups. They are made and used independently of each other, are not art-recognized equivalents.

For the above reasons, the restriction is still deemed proper and is therefore made FINAL.

Specification

1. Applicant is reminded of the proper content of an Abstract of the Disclosure.

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In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on February 21, 2001. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1). The use of "a heterocyclic ring" in the definition of R1, page 34 and "heteroarylalkyl" in the definition of R6, page 35 is unclear to the array of heteroatoms, size of the rings, as well as nature of atoms as ring members. See *In re Wiggins* 179 USPQ 421 for certain terminology regarding heterocyclic ring systems.

2). A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent

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protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "a saturated, unsaturated, cyclic, and/or (hetero)aromatic organic radical", and the claim also recites "especially, a straight or branched alkyl chain..." which is the narrower statement of the range/limitation. The rejection is also applicable to the phrase "in which A is an alkylene group with 1-4C atoms, especially with 1C atom..." (page 33, last line). It is also unclear to the Examiner how "a straight or branched alkyl chain" belongs to the category of "a saturated, unsaturated, cyclic, and/or (hetero)aromatic organic radical," which appears to be the definition for a ring structure.

3). The phrase "optionally substituted" throughout claim 1, pages 34 and 35, is unclear as to the nature and number of substituent(s) intended.

4). In Claims 1 and 16, the phrase "general formula" recites more than what is positively described. Deletion of the word "general" is suggested.

5). Claims 1-16 are vague in that it is unclear whether the variable $-W=X=Y-$ is independent or belongs to the definition of R6. It also appears that some words are missing between $-W=X=Y-$ and "the groups" on page 35.

6). Claim 10 recites the limitation "G-C=C". There is insufficient antecedent basis for this limitation in the claim.

7). Claim 2 recites the limitation " $W-X-Y$ ". There is insufficient antecedent basis for this limitation in the claim.

3. 8). Claims 14 and 15 provides for the use of the compounds, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 14 and 15 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

Claims 1-16 are objected to as being an improper Markush grouping. The recited compounds, while possessing a common utility, present a variable core and, thus, the Markush groups represented by the term where $-W=X=Y-$ is $-C=C-N-$ and -

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W=X=Y- is -N-C=C- or -N-N=C- have variably different definitions, render the claims clearly improper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hong Liu whose telephone number is 703 3065814.

The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703 308 4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-4556 for regular communications and 703 3084734 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 358-1235.

F Bernhardt (Acting SP2)

**Mukund Shah
Supervisory Patent Examiner
Art Unit 1624**

hl
December 24, 2003

**EMILY BERNHARDT
PRIMARY EXAMINER
GROUP 128 / 1200**